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10/696,381

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Albert K. Chin

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EXAMINER

SMITH, PHILIP ROBERT

ART UNIT

PAPER NUMBER

3739

MAIL DATE

DELIVERY MODE

06/01/2010

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/696,381 | <b>Applicant(s)</b><br>CHIN, ALBERT K. |  |
|                              | <b>Examiner</b><br>PHILIP R. SMITH   | <b>Art Unit</b><br>3739                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 15-35 is/are pending in the application.
- 4a) Of the above claim(s) 27-35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 15-22 and 26 is/are rejected.
- 7) ☒ Claim(s) 23-25 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Finality of the Previous Rejection**

- [01] In view of the Pre-Appeal Conference of 3/31/2010, the rejection of 11/5/09 is withdrawn.
- [01a] It was concluded that rejections under 35 USC 112 1<sup>st</sup> are improper, as the claims were supported by the specification, albeit in a divergent embodiment.
- [01b] It was concluded that Horzewski (5,318,588) in view of Chin (6,264,670) did not prevent patentability under 35 USC 103.
- [02] New grounds of rejection are set forth below in response to the claims filed 6/18/09.

### **Election**

- [03] Claims 27-35 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected embodiment, there being no allowable generic or linking claim.
- [04] These claims are supported by Figures 5-6 and their corresponding description. But the originally presented claims are directed to the embodiment of Figures 1A-1C. The embodiment of Figures 5-6 was not searched. The rejections under 35 USC 112 and 35 USC 103 of the corresponding claims (27-35) were based on a mistaken belief that the corresponding claims were directed toward the same embodiment as the originally presented claims.

### **Claim Rejections - 35 USC § 112, Paragraph One**

- [05] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- [06] The rejection of claim(s) 27-35 set forth in the Office action of 11/5/09 are withdrawn in view of the Pre-Appeal Conference of 3/31/10.

### **Double Patenting**

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- [07] The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).
- [08] A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.
- [09] Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).
- [10] Claims 15-22 & 26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,607,547. Although the conflicting claims are not identical, they are not patentably distinct from each other.

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[10a] Claim 15 recites “an elongated instrument having a distal tip configured to dissect tissue, wherein the distal tip is transparent” whereas the conflicting claim recites “[a]n inner cannula ... having a transparent tip”. Claim 15 is broader than the conflicting claim in the sense that “elongated instrument” is broader than “inner cannula”, which is a particular kind of “elongated instrument”. The only remaining distinction is that claim 15 is “configured to dissect tissue”. But the “dissection” discussed in the specification is merely the placement of the instrument in a position where it can dilate tissue. An “inner cannula”, as a skilled artisan would understand it, is configured to be placed between tissues which are to be dilated.

[10b] Claim 15 further recites “an outer sheath disposed about at least a portion of the elongated instrument” whereas the conflicting claim recites “an outer sheath disposed over the inner cannula.

[10c] Claim 15 further recites that the outer sheath has “a distal portion that is expandable in an outward direction in response to a relative movement between the elongated instrument and the outer sheath” whereas the conflicting claim recites that the outer sheath “expands outwardly in response to the expansion device of the inner cannula being disposed within the outer sheath”.

### **Claim Rejections - 35 USC § 103**

[11] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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- [12] The rejection of claim(s) 15, 21-23, 25-31 & 34-35 as being unpatentable over Horzewski (5,318,588) in view of Chin (6,264,670) as set forth in the Office action of 11/5/09 are withdrawn in view of the Pre-Appeal Conference of 3/31/10.

#### **Allowable Subject Matter**

- [13] Claims 23-25 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### **Response to Arguments**

- [14] Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

#### **Conclusion**

- [15] Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
- [16] A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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- [17] Any inquiry concerning this communication or earlier communications from the examiner should be directed to PHILIP R. SMITH whose telephone number is (571)272-6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm.
- [18] If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764.
- [19] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Philip R Smith/  
Examiner, Art Unit 3739